

REMARKS/ARGUMENTS

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Final Official Action provided. Applicant also notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed on December 13, 2004 and April 28, 2005 by the return of the initialed and signed PTO-1449 forms. Applicant further gratefully acknowledges the Examiner's indication of the allowability of claims 15, 16, 24 and 25.

Upon entry of the present paper, claims 14 and 23 will have been amended to clarify the claim language therein, with claims 1-31 remaining pending for consideration by the Examiner. Applicant notes that the listing of the amended reissue claims is in conformance with 37 C.F.R. § 1.173(2). Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

Applicant notes that the Examiner has maintained the provisional non-statutory double-patenting rejection of claims 14-31 in view of claims 14-31 of copending application 10/815,193. Applicant again notes that submitting a terminal disclaimer concurrently herewith would be premature, since all the claims of either application have not yet been allowed. Once all the claims of both application have been indicated to be allowable, Applicant will then consider submitting such a terminal disclaimer.

Turning to the merits of the action, the Examiner has rejected claims 14, 17, 19, 21-23, 26, 28, 30 and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,768,048 to WAKABAYASHI, finding that this reference teaches all limitations of these claims.

Applicant respectfully traverses the Examiner's rejection. While the embodiment shown in Fig. 13 of WAKABAYASHI shows a portion of a main lens 3 and a portion of a sub lens 4 located along a common plane which is generally perpendicular to the optical axis, this reference fails to teach or suggest at least that when the lens barrel is in all of the plurality of photographic positions, all of the optical elements are positioned along the optical axis (as substantially claimed in claim 14), or that when the lens barrel is in all of the plurality of photographic positions, all of the imaging elements are positioned along the optical axis (as substantially claimed in claim 23). Specifically, since the WIDE photographic position shown in Fig. 13 of WAKABAYASHI (analogous to Fig. 2 therein) *does not* have all lens groups along the optical axis. Solely in order to expedite the prosecution of the present application, Applicant has amended claims 14 and 23 to more clearly recite that when the lens barrel is in all of the photographic positions, all of the elements are positioned along the optical axis.

It is therefore respectfully submitted that WAKABAYASHI, as well as the other references of record, fails to teach or suggest the invention of independent claims 14 and 23, as well as the claims dependent therefrom.

With respect to the Examiner's rejection of dependent claims 17, 19, 21, 22, 26, 28, 30 and 31 under 35 U.S.C. § 102(b), since these claims are dependent from either allowable independent claims 14 or 23, which are allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied

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reference fails to disclose each and every element recited in independent claims 14 and 23, and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(b).

With respect to the Examiner's rejection of dependent claims 18, 20, 27 and 29 under 35 U.S.C. § 103(a), since these claims are dependent from either allowable independent claims 14 or 23, which are allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record.

Further, Applicant asserts that the amendment to the claims does not raise new issues and/or require the Examiner to conduct an additional search. Rather, as discussed *supra*, the amendments to the claims are clarifying amendments that are cosmetic in nature and that explicitly render what was already implied by these claims (*i.e.*, that when the lens barrel is in all of the photographic positions, all of the elements are positioned along the optical axis). The Examiner is thus respectfully requested to exercise his discretion in this regard.

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

COMMENTS ON STATEMENT OF REASONS FOR THE INDICATION OF ALLOWABLE  
SUBJECT MATTER

In response to the Statement of Reasons for the Indication of Allowable Subject Matter, mailed by the Patent and Trademark Office on June 3, 2005, along with the above-noted Office Action, Applicant wishes to clarify the record with respect to the basis for patentability of the allowed claims in the present application. In this regard, while Applicant does not disagree with the Examiner's indications that certain identified features are not disclosed by the prior art references, as noted by the Examiner, Applicant further wishes to clarify that each of the independent claims in the present application recites a particular combination of features, and the basis for patentability of each of these claims is further based on the particular totality of the features recited therein. The dependent claims set forth additional basis for their patentability in accordance with their recited limitations as well as in accordance with the particular limitations of the respective base claims.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present paper is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipates or renders obvious Applicant's invention. Accordingly, consideration of the present Response, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

With respect to Applicant's amendment of claims 14 and 23, Applicant submits that this Amendment has not been made for a purpose related to patentability, but rather, as discussed *supra*, is a clarifying amendment that is cosmetic in nature and that explicitly renders what was already implied by these claims (*i.e.*, that when the lens barrel is in all of the photographic positions, all of the elements are positioned along the optical axis). Thus, this amendment is not intended to narrow the scope of the claims, and should not be considered a decision by Applicant to narrow the claims in any way.

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Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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A handwritten signature in dark ink, appearing to read "W.H. Bernstein", is written over a horizontal line.

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